REMARKS

Claims 1-31 are pending in the application at this time. Claims 1, 26, 27, 30, and 31 are independent claims. Claims 1-3, 6-8, 12-15, 18, 20, 22, 23, 25, 27, 28-31 have been amended. Claims 32-48 have been added. Claims 11, 16, 17, 19, 21, 26, and 30 have been cancelled. Reconsideration is requested based on the amendments and the following remarks.

1.   Information Disclosure Statement

The Information Disclosure Statement filed on 2/27/02 was not considered by the examiner for failing to comply with the provisions of 35 CFR 1.97, 1.98 and MPEP § 609. A new Information Disclosure Statement is being submitted that complies with these provisions. The applicant believes that the subject matter disclosed in the new Information Disclosure Statement contains information equivalent to that in the old Information Disclosure Statement.

2.   Response to Rejections Under Section 35 USC §102(b)

Claims 1-7, 11-22, 27-28, and 31 stand rejected under 35 U.S.C. 102(b) as being anticipated by International Patent No. WO 99/22313, published on 05/1999, to Warmus et al. ("Warmus"). Claims 11, 16-17, 19, 21, and 26 have been cancelled, rendering the rejection moot as to those claims. As to the rest of the claims, the applicant respectfully traverses the rejection.

a. Claim 1-7, 12-15, 18, 20, and 22

Amended claim 1 recites a method for generating a document. The method comprises inserting one or more variable content placeholders in the document, and binding each placeholder to a content source. Each placeholder has representative content, and the representative content has associated formatting information. The method includes presenting, in an edit mode, the representative content of the variable content placeholders according to the corresponding associated presentation data.

Warmus discloses a method for producing different versions of books and/or customized books within a single press run. Page 2, lines 1-3. In Warmus, one or more template files are

developed for the different books or book versions specifying the content (including appearance) of fixed information and the positioning of all information (i.e., fixed and variable). Page 23, line 32 – Page 24, line 3. Variable information for a book can include variable text elements, variable image elements, and variable graph elements. In Warmus, the user identifies the database fields in the variable database to be used for the variable text, image, and graph elements. Page 28, lines 25-27. For variable text elements, a name or an indication of the appropriate field in the database in placed in the template file. Page 28, lines 29-33. For variable image elements, a dummy picture file and an indication of the proper database field to be used for the variable image element is inserted in the template file. Page 29, lines 10-13. A user viewing the page on a computer display will see the dummy picture file and the indication of the database field at the insertion point. Page 29, lines 13-18. For variable graph elements, an image box is created at the selected area of the page, and a text box is layered over the image box. The graph parameters and data pairs representing the graph data are stored in the text box. The graph parameters include the type of graph (i.e., bar graph or pie chart) as well as size, labels, colors, etc.

Warmus does not disclose variable content placeholders having a representative content, with the representative content having associated formatting information. In addition, Warmus does not disclose an edit mode where the variable content placeholders are presented by presenting the representative content according to the corresponding associated formatting information. Instead, in Warmus, the placeholders are displayed as area data representing any areas on the page where variable information is to be reproduced. Page 24, lines 18-19. Because Warmus fails to disclose at least these limitations of claim 1, the reference cannot anticipate that claim. For at least these reasons, claim 1 is allowable over Warmus. Claims 2-7, 12-15, 18, 20, and 22 depend directly or indirectly from claim 1 and are therefore allowable for at least the same reasons.

b. Claim 7

Claim 7 is allowable over Warmus for at least the following additional reason. As amended, claim 7 includes embedding the code as attributes in the variable content placeholder.

As described above, Warmus discloses creating variable graph elements by storing the graph parameters and data pairs representing the graph data in a text box. Warmus also discloses tagging the text box so that an interpreter used to generate the page recognizes that the text box represents information to be used to generate the graph. Page 30, lines 25-31. Warmus discloses tagging the text box by assigning an unusual attribute, i.e., color or font, to the text box. Page 8, lines 1-17.

Warmus does not disclose embedding code generated by compiling a variable content placeholder as attributes in the placeholder. The attributes assigned to the text box in Warmus are only used to detect a text box associated with variable graph elements. In Warmus, the text box attributes are not used to embed code associated with a variable content placeholder. The applicant respectfully submits that claim 7 is allowable over Warmus for at least these additional reasons.

c. Claims 27, 28 and 31

Claim 27 is directed to a computer program product that comprises instructions operable to cause a programmable processor to perform method steps directly analogous to those recited in claim 1. Claim 31 is directed to a system that includes means for performing such steps. Accordingly, claims 27 and 31, and claim 28 which depends from claim 27, are allowable over Warmus for at least the reasons discussed above in the context of claim 1.

3. Response to Rejections Under Section 35 USC §103(a)

Claims 8-10, 23-26, and 29-30 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Warmus, in view of U.S. Patent No. 5,845,303, to Templeman ("Templeman"). Claims 26 and 30 have been cancelled rendering the rejection moot as to those claims. As to the rest of the claims, the applicant respectfully traverses the rejection.

a. Claims 8-10

Amended claim 8 depends from claim 1 and specifies that the placeholder is a mark-up element.

As discussed above, Warmus fails to disclose, or even suggest, a method in which variable content placeholders having a representative content, that in turn have associated formatting information, are presented by presenting the representative content according to the corresponding associated formatting information, as claim 1 requires. The Examiner cites Templeman as allegedly disclosing the use of mark-up elements as variable content placeholders, which the Examiner admits is not disclosed or suggested in Warmus. However, like Warmus, Templeman does not disclose or suggest the presentation of variable content placeholders by presenting representative content of the placeholders according to associated formatting information.

Templeman discloses using a plurality of tags for text and graphics data to be displayed using a metaform. Col 5, lines 53-56. Templeman discloses using the tags to indicate the frame within the metaframe to which the data is assigned, and using style and formatting information in the tag to modify the style and formatting information of the frame. Page 6, lines 45-48 and Page 6, line 66 – Page 7, line 18. Templeman does not disclose or suggest variable content placeholders having a representative content, with the representative content having associated formatting information. In addition, Templeman does not disclose or suggest an edit mode where the variable content placeholders are presented by presenting the representative content according to the corresponding associated formatting information. Because Warmus and Templeman, alone or in combination, fail to disclose or suggest at least these limitations of claim 8, no *prima facie* case of obviousness has been established, and claim 8 is allowable. Claims 9, and 10 depend from claim 8 and are therefore allowable for at least the same reasons.

b. Claim 23-25

Amended claim 23 depends from claim 1, specifies that the step of inserting one or more variable content placeholders includes inserting one or more mark-up elements. Accordingly, claim 23 is allowable over Warmus and Templeman for at least the reasons discussed above in

the context of claims 8-10. Claims 24, and 25 depend directly or indirectly from claim 23, and are therefore allowable for at least the same reasons.

c. Claim 29

Amended claim 29 is directed to a computer program product that comprises instructions operable to cause a programmable processor to perform method steps directly analogous to those recited in claim 23. Accordingly, claim 29 is allowable over Warmus and Templeman for at least the same reasons discussed above in the context of claim 23.

4. New Claims

New claims 32-36 are method claims depending directly or indirectly from claim 1, and are therefore allowable for at least the reasons discussed above in the context of that claim. New claims 37-46 are computer program product claims depending directly or indirectly from claim 27, and are therefore allowable for at least the reasons discussed above in the context of that claim. New claims 47 and 48 are system claims depending directly or indirectly from claim 31, and are therefore allowable for at least the reasons discussed above on the context of that claim.

5. Conclusion

The applicant submits that all claims are in condition for allowance and requests that all claims be allowed.